

Appl. No. 10/054,300
Response to Office Action mailed April 14, 2006

R E M A R K S

The Examiner is respectfully requested to acknowledge applicants' claim for priority under 35 USC 119 and receipt of the certified copy of the priority document.

The Examiner is also respectfully requested to return copies of the Forms PTO/SB/08A and PTO/SB/08B filed on April 19, 2002; the Form PTO/SB/08A filed on March 9, 2004 and the Form PTO/SB/08A filed on April 1, 2004, and to indicate thereon that the cited publications were considered and made of record.

Restriction was required under 35 USC 121 as follows:

Group I. Claims 1 to 10 and 23 to 28, drawn to compounds of formula 1 where B is a purine base;

Group II. Claims 1 to 10 and 23 to 28, drawn to compounds of formula 1 where B is a pyrimidine base;

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Group III. Claims 11 to 13 and 19 to 22, drawn to oligonucleotides comprising the compound of formula Ia;

Group IV. Claim 14, drawn to a composition comprising the oligonucleotide of Group II; and

Group V. Claims 15 to 18, drawn to methods of treating or preventing diseases using the oligonucleotide of Group II.

Applicants elect Group II, claims 1 to 10 and 23 to 28, drawn to compounds of formula 1 where B is a pyrimidine base, with traverse.

Applicants traverse the Restriction Requirement on the grounds that the compounds of formula 1, wherein B is a pyrimidine base (Group II), should be examined with the compounds of formula 1, wherein B is a purine base (Group I). This is evidenced by the fact that in another application examined in

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the Group Art Unit where this application was examined (Group Art Unit 1623), pyrimidine and purine were examined together (see the enclosed copy of the cover sheet (first page) and claims of USP 6,268,490). Furthermore, nucleosides were examined together with oligonucleotides in the application that issued as USP 6,268,490. It is respectfully submitted that it follows that the claims of Group I and Group II in the present Restriction Requirement should be examined together.

Moreover, the Examiner classified Groups I and III in the same class (class 536), and classified Groups IV and V in the same class (class 514) and same subclass (subclass 44). This is an additional reason why the Restriction Requirement should be withdrawn.

In the second paragraph on page 6 of the Office Action, applicants were required to elect a single disclosed species.

As a single disclosed species, applicants elect the compound of Example 3, namely, 3'-amino-3'-deoxy-2'-O,4'-C-methylene-5-

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methyluridine (see pages 79 to 80 of the specification)
(Exemplification compound number 2-4) (see claim 10).

The Restriction Requirement concerning the election of a species is respectfully traversed on the ground that it is not a species requirement of the type set forth in the third paragraph of MPEP 803.02 entitled "PRACTICE RE MARKUSH TYPE CLAIMS." It is respectfully submitted that the practice set forth therein and in the decisions cited in MPEP 803.02 are the proper practice to be applied in the present case and to the extent that the Restriction Requirement is not consistent therewith, it is respectfully traversed.

If, however, the Restriction Requirement is maintained, then taking into consideration that there are generic claims, it is respectfully requested that the provisions of 37 CFR 1.141(a) and the procedure set forth in MPEP 806.04(d) be followed, which provide that once a claim that is determined to be generic is allowed, all the claims drawn to species, in addition to the elected species which include all the limitations of the generic claim, should be allowed.

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Reconsideration is respectfully requested.

If the Examiner has any comments, questions, objections or recommendations, the Examiner is invited to telephone the undersigned at the telephone number given below for prompt action.

Respectfully submitted,



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Enclosure: copy of the first page and the claims of
USP 6,268,490